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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,187	04/26/2001	Thomas M. Baer	ARC012001800	2124

34690 7590 03/23/2006

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2707 18TH STREET  
SAN FRANCISCO, CA 94110

EXAMINER
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CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/844,187

Applicant(s)

BAER ET AL.

Examiner

LaToya C. Younger

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13,79-82 and 93-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-13,79-82,94-96,101-103 and 105-108 is/are allowed.
- 6) ☒ Claim(s) 1-4,93,97-100 and 104 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 9, 2006 has been entered.

### *Claim Rejections - 35 USC § 103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-4, 93, 97-100, 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansour in view of US patent 6,720,191 to Goldstein et al.

Mansour discloses an assay device for collecting and testing biological samples. The device comprises a base (45) having a composite material (41) onto which a biological sample is disposed. The base having the biological sample is considered to be a "carrier". The carrier mates with a cover portion (46). The cover portion has an aperture (48), which is a conduit running from the top of the cover to the bottom of the cover. When the cover is mounted onto the base, the sample carrier closes the bottom part of the conduit and forms a reservoir (47). There are portions of the carrier on both sides of the conduit that are not in communication with the conduit. In fact a part of the cover covers a portion of the carrier and excludes a part of the carrier from being in communication with the conduit. See figure 5, where a portion of the composite material (41) lies outside of the reservoir (47). Mansour further discloses that a well (10) may be mated with cover at the conduit for delivering fluids into the conduit (col. 12, lines 1-7).

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Mansour differs from the instant invention in that the amended claims recite that the carrier closes the first opening so that fluid flow is prevented through the bottom surface of the carrier. Mansour discloses an absorbent multi-layered carrier that would allow flow through the absorbent layers. However, Goldstein et al teach pressure adhesive tapes for use in laser capture microdissection. The tape collects a tissue sample and is subjected to activation by a pulsating laser beam causing the adhesive to flow around the tissue sample and adhere the sample to itself. Further processing and analysis of the sample follows. Goldstein et al teach an alternative carrier to the absorbent carrier disclosed in Mansour. It would have been obvious to one of ordinary skill in the art to incorporate the pressure-sensitive adhesive carrier into the carrier receiving device of Mansour to provides a means of capturing and analyzing a different type of sample (such as a solid sample) that would not be possible with the absorbent carrier disclosed by Mansour. Such modification would involve mere substitution of one known type of carrier for another known type of carrier, as discussed in MPEP 2144.07.

#### *Allowable Subject Matter*

4. Claims 5-13, 79-82, 94, 95, 96, 101-103 and 105-108 are allowed for the reasons set forth in the previous Office Action.

#### *Response to Arguments*

5. Applicant's arguments filed on February 9, 2006 have been fully considered but they are considered to be persuasive.

Applicants' arguments in response to the obviousness rejection over Mansour in view of Goldstein is directed to the fact that Mansour discloses a flow through device while the carrier of Goldstein does not allow flow through of fluids. Because of such, Applicants allege that the references are not combinable, no motivation exists to combine, hindsight reasoning was used in forming the

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rejection, the Mansour would not be able to carry out its intended function if the modification takes place and the proposed modification requires substantial reconstruction.

The Examiner notes that Mansour teaches a flow through device, however, the nature of the flow-through device of Mansour has been misconstrued. Figure 5 of Mansour shows a laminate absorbent layer structure as the "carrier" in the device. The absorbent structure is necessary for liquid analysis so that the liquid sample reaches the assay reagents and accurate results can be obtained. Nothing in Mansour would preclude substituting the absorbent laminate with a carrier such as the pressure adhesive tape of Golstein for analysis solid samples. The device of Mansour does indeed have a bottom, designated as the base (45). The fluid sample in the device of Mansour does not flow through the entire device – it merely flows through the absorbent layers so that analytes in the sample can bind with the reagent.

The Examiner's proposed modification is simple – to remove the absorbent structure and replace it with a pressure adhesive tape that would be more suitable for solid sampling and analysis. No hindsight reasoning need be used, since Mansour teaches that absorbent layers are preferable for liquid samples and Goldstein teaches that pressure adhesive tapes are preferable for solid samples. The modification would allow the device of Mansour to function in the manner disclosed, the only difference being the carrier type.

MPEP 2144.07 states that it is prima facie obviousness to substitute equivalents known for the same purpose. Both the absorbent layers of Mansour and the pressure adhesive tapes of Goldstein serve to collect a sample for analysis. Thus, it would have been obvious to one of ordinary skill in the art to substitute one for the other.

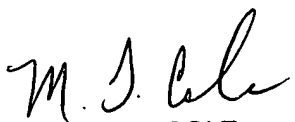
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya C. Younger whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Thursday 10:30 a.m. - 7:00 p.m. and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**MONIQUE T. COLE**  
**PRIMARY EXAMINER**